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# **In the Supreme Court of the United States**

OCTOBER TERM, 1946

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No. 120

BENJAMIN WAITE BLANCHARD, JR., PETITIONER

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS

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*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA*

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**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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## **OPINIONS BELOW**

The district court rendered no opinion. The findings of fact and conclusions of law of that court (R. 8-9) are not reported. The opinion of the United States Court of Appeals for the District of Columbia (R. 85-87) is reported at 153 F. 2d 651.

## **JURISDICTION**

The judgment of the court of appeals was entered on February 25, 1946 (R. 88). The petition for a writ of certiorari was filed on May 24, 1946. The jurisdiction of this Court is invoked

under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTIONS PRESENTED

1. Whether, in a proceeding brought under Section 4915 of the Revised Statutes of the United States, *infra*, pp. 12-13, to authorize issuance of a patent, the court below erred in affirming the holding of the district court that petitioner's radio antenna did not constitute invention.

2. Whether the court below erred in holding that an applicant for a patent based entirely upon an assembly into one structure of several features covered by prior patents, which assembly is expected to produce unexpectedly superior results, must show by comparative evidence that his device has the alleged superiority over the devices embraced in the prior patents.

#### STATUTES INVOLVED

The statutes involved are set forth in the Appendix, *infra*, pp. 12-13.

#### STATEMENT

Petitioner brought suit in the District Court of the United States for the District of Columbia under Revised Statutes, Section 4915 (35 U. S. C. 63) to obtain a judgment which would authorize the Commissioner of Patents to issue a patent on a radio antenna (R. 1-6).

The application for a patent, containing six claims<sup>1</sup> (R. 37-44), was filed by petitioner on April 7, 1939 (R. 72). The examiner rejected the claims as unpatentable over six prior patents relating to antennae, stating that "the device claimed is not seen to be other than equivalent to any ordinary type of capacity plate or coil antenna." (R. 67.) The examiner also pointed out that the applicant had been requested to demonstrate the device, in view of the striking results said to be obtained from the use of his antenna.

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<sup>1</sup> Illustrative of the claims is number 5 in which it is stated (R. 3-4): "A radio antenna, comprising duplicate sets of a plurality of flattened windings of different longitudinal and transverse measurements, nested together with their sides in relatively close parallel relation with one another, a metallic conductor extending through the smallest winding of each set and to which one end of each of the smallest windings is connected, the other end of each smallest winding being open, pairs of metallic conductors at the ends of said windings sets extending parallel with said first conductor, one end of each of the outside windings of each set being connected to one of the conductors of each end pair, and one end of each of the intermediate windings of each set being connected to one of the conductors of the other end pair, the opposite ends of said outside and intermediate windings being open, and wire mesh screens upon the opposite flattened sides of and parallel with said windings, one end of each of said screens being connected to one conductor of one end pair and its other end being connected to the opposite conductor of each end pair to provide connecting leads of different lengths, and a conductor extending longitudinally of and between said winding sets to connect said first conductor and said pairs of end conductors together, and provide a lead for connection to a radio receiving device."

The requested demonstration was refused, but certain affidavits were submitted. (R. 69.) The holding of the Examiner was affirmed by the Board of Appeals in the Patent Office (R. 72-74).

The district court, after hearing the evidence which included a demonstration of the antenna (R. 17-18, 26-27, 29), entered judgment dismissing the complaint (R. 10). The court found that in view of the various arrangements of metal windings and of wire screens in radio antennae as disclosed by the prior patents, the particular arrangement of windings and screens claimed by the plaintiff involved nothing more than ordinary skill of the mechanic; that it had not been shown that the particular arrangement set forth in the claims involved in this action produced any new or unexpected result or was superior to the generally similar arrangements disclosed in the various prior patents; that none of the claims set forth in the complaint defined invention in view of the prior art; and that all the claims set forth in the complaint were unpatentable in view of the prior art (R. 9). On appeal the court below affirmed the judgment of the district court (R. 85-88).

#### ARGUMENT

1. The primary question presented, namely, whether the device defined in petitioner's claims constitutes invention, is one of fact. *United States v. Esnault-Pelterie*, 299 U. S. 201, 205;

*Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446. At the trial petitioner adduced evidence purporting to show that his radio antenna obtained clearer, more distant, and better non-directional radio reception than other *unidentified* radio antennae. Although his antenna is but an assembly of the elements of prior patents in the radio antenna art, petitioner presented no comparative evidence from which the court could determine to what extent and in what respect his antenna obtained improved results over the antennae covered by the prior patents. On the evidence adduced by petitioner and the prior patents, the trial court found that petitioner had not shown that his antenna obtained any new or unexpected result, and that he had not shown invention in view of the prior art. The conclusions of the trial court were affirmed by the court below, the latter court stating that the burden was on petitioner to show by comparative test that his antenna was more than a mere mechanical going forward of the prior art. We submit that the evidence in this case would not support a conclusion contrary to that reached by the trial court and the court below.

The findings of the trial court are not to be set aside unless clearly erroneous. Rule 52 (a), F. R. C. P.; *Adamson v. Gilliland*, 242 U. S. 350; *Warren v. Keep*, 155 U. S. 265. This principle is applicable to proceedings under R. S. § 4915.

*Magnaflux Corp. v. Coe*, 139 F. 2d 531 (App. D. C.); *General Motors Corp. v. Coe*, 120 F. 2d 736 (App. D. C.), certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715; *Forward Process Co. v. Coe*, 116 F. 2d 946 (App. D. C.). In the case at bar the Patent Office, the district court, and the court of appeals are all in agreement as to the inferences to be drawn from the facts adduced. This fortifies the conclusion that the findings are not erroneous. See *United States v. Commercial Credit Co., Inc.*, 286 U. S. 63, 67; *Williams Manufacturing Co. v. Shoe Machine Corp.*, 316 U. S. 364, 367; *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275, 278; *Abbott v. Coe*, 109 F. 2d 449, 451-452 (App. D. C.). Issues of fact in cases of this character are not ordinarily reviewed by this Court. "An ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent." *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; cf. *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175.

2. Petitioner's antenna consists of a metal grid, wire windings located one within another, and



flat pieces of metal screen (R. 37). Each of these elements alone is old in the radio antenna art. Thus, grids are shown by Graves (R. 80), wire windings located one within another by Jones (R. 77), Bodoh (R. 78), and Clark (R. 79), and flat surfaces of metal screen by Arias (R. 75). These elements have been assembled by petitioner into a single device, which he claims to be an invention on the ground that the combination obtains better results than any of the old elements. It is clear that the various elements of the prior radio antenna art may be mechanically arranged in an almost unlimited variety of ways which do not amount to invention, because, as the court below held with respect to petitioner's combination, such arrangements represent only the "ordinary skill of the mechanic" (R. 87). Under such circumstances, they do not constitute invention. *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U. S. 327, 330; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 486. In adversely disposing of petitioner's claim that his combination of previously patented elements constituted invention, the court below held that the burden was upon petitioner to show more than a mere mechanical going forward with the components set out in the prior patents, and that since petitioner

alleged superiority over the prior art, the burden was upon him to prove such superiority. These principles have received the approval of this Court. *Smith v. Nichols*, 21 Wall. 112, 119; *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp.*, *supra*; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177; *Electric Cable Joint Co. v. Brooklyn Edison Co., Inc.*, 292 U. S. 69.

Petitioner objects (Pet. 13) to the statement made by the court below in the course of its opinion that petitioner was obliged to show by comparative test, at least, that his device produced unusual and superior results in comparison with the prior art. Petitioner contends that this holding is erroneous in that it imposes upon him the burden of showing comparative utility, whereas, he asserts, the rulings of this Court in patent cases require no more than a showing of mere utility. To support his contention he points to the statements in the opinion of this Court in the case of *Seymour v. Osborne*, 11 Wall. 516, 549, to the effect that in connection with improvements for which patents may be granted the law as to utility is satisfied if the combination is new and useful, and that the improvement need not be of such general utility as to supersede all other inventions in practice to accomplish the same object. From this he argues that it was necessary for him to show only that the elements assembled by him

have a utility, and that the patents, themselves, are the best evidence of what they will accomplish.

We submit that the statement of the court below to which petitioner takes exception is a correct exposition of an established rule of evidence, the application of which to patent questions has long had the approval of this Court. In his argument petitioner completely ignores the pertinent and significant pronouncement made by this Court in *Seymour v. Osborne*, *supra*, with respect to the character of proof necessary to determine questions concerning the scope of patent coverage. In that case this Court at page 559, citing its prior decision in *Blanchard v. Putnam*, 8 Wall. 420, 426, said as follows:

Where the invention or inventions are embodied in a machine the question of infringement is best determined by a comparison of the *machine* made by the respondent with the *mechanism* described in the complainant's patent or patents, where more than one is embraced in the same suit. [Italics supplied.]

This rule was reiterated in even stronger terms in the later case of *Bates v. Coe*, 98 U. S. 31, 49.<sup>2</sup>

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<sup>2</sup> In that case the court said:

"Where the invention is embodied in a machine, manufacture, or product, the question of infringement, which is a question of fact, is ordinarily best determined by a comparison of the exhibit made by the respondent with the mechanism described in the complainant's patent."

The question of invention, like that of infringement, is one of fact. It follows, therefore, that the alleged superiority of petitioner's device should have been proved by comparative evidence. Petitioner failed to adduce such evidence.

The rule contended for by petitioner, that the prior patents are the best evidence of what they will accomplish, would be plainly inadequate in a case such as this, where all of the elements of the device sought to be patented are embraced in prior patents. The evidence adduced at the trial by petitioner was to the effect that petitioner's device obtains clearer, more distant, and better non-directional radio reception than other *unidentified* radio antennae (R. 11-36, 44-62). Since the antennae used by petitioner's witnesses were not identified by them as the antennae covered by the prior patents, this evidence was plainly inadequate to apprise the trial court whether petitioner's device was anticipated by those patents, or whether petitioner's device was an improvement, amounting to invention. And it is obvious that the trial court could not, by merely reading the patents, compare the relative clearness and reach and the non-directional betterment of the radio reception obtainable by the antennae covered by the patents with that obtainable by petitioner's device for which he seeks a patent. We submit that it would have been impossible for the trial court to determine

the issues in this case favorable to petitioner from a mere visual examination of the prior patents, and that the court below committed no error in stating that the petitioner was obliged to show by comparative evidence that his device obtains a result which is more than a mere mechanical going forward with the components set out in the prior patents.

#### CONCLUSION

The decision of the court below is correct. The case presents no question of public importance, and there are no conflicts of decision. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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JUNE, 1946.

## APPENDIX

Section 4886 of the Revised Statutes (35 U. S. C. 31):

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Section 4915 of the Revised Statutes (35 U. S. C. 63):

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in

equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.